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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,067	11/17/2003	Richard York	100202702-1	4783

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INTELLECTUAL PROPERTY ADMINISTRATION		
FORT COLLINS, CO 80527-2400		

EXAMINER	
HEWITT II, CALVIN L	

ART UNIT	PAPER NUMBER
3600	

NOTIFICATION DATE	DELIVERY MODE
01/29/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/716,067

Applicant(s)

YORK, RICHARD

Examiner

Calvin L. Hewitt II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Status of Claims

1. Claims 1-13 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: determining a risk class for an order.

Claims 2-13 are also rejected as each depends from claim 1.

4. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "high risk", "medium risk" and "low risk" in claim 1 are relative terms which, renders the claim indefinite. The terms "high risk", "medium risk" and "low risk" are not defined by the claim, the specification does not provide a

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standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Claims 2-9 are also rejected as each recites at least one of "high risk", "medium risk" and "low risk".

Claims 2-13 are also rejected as each depends from claim 1.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6 and 8-13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hillmer et al., U.S. Patent No. 6,714,918.

As per claims 1-6, 8 and 10-13, Hillmer et al. teach a method for determining a risk for fraud comprising:

- receiving an order from a customer (column 4, lines 5-26) wherein an order is received in a website (column 4, lines 13-15) or a call center

(column 4, lines 10-12) for a product or service (column 4, lines 45-51 and 55-59)

- evaluating an order based upon indicators of possible high-risk activities (column/line 4/38-5/38; column/line 9/58-10/22)
- determining a risk class (column 6, lines 20-65; column/line 8/58-10/22; column 12, lines 14-60) for an order as “low” (column 6, lines 58-65), “medium” (column 6, lines 20-34) and “high” (column 12, lines 50-60) wherein length of processing time is directly proportional to the order risk (column 6, lines 20-34 and 58-60; column 12, lines 50-60)
- indicators for possible high or medium risk activities are order amount exceeding a threshold, shipping address, non-domestic IP address, card verification number authorization code, address verification code, order quantity, CVN codes or shipping address (column/line 4/52-5/30; column/line 9/58-10/22)

As per claim 9, claim 1 recites conditional or optional language (e.g. if the order is high risk, if the order is a medium risk). However, language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (*Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); *In re Collier*, 158 USPQ 266 (CCPA 1968); *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); MPEP 2106 II C). Therefore, a

reasonable interpretation of claim 1 is wherein the order is high risk, medium risk or low risk. Further, as in the case of "or language", the prior art need only perform one of the possibilities (e.g. high risk) in order to read on a claim and claims that depend on the other possibilities (e.g. medium risk) are not given patentable weight.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillmer et al., U.S. Patent No. 6,714,918.

As per claims 7 and 9, Hillmer et al. teach determining a score in order to determine a transaction risk (figures 1 (item 118), 2A(1), 2A(2), 2B(1) (item 324, 326, and 328), 2B(2), and 3A(1) (items 416, 426 and 430); column/line 9/58-10/22). Hillmer et al. do not specifically disclose eFalcon scores. However, as eFalcon scores are old and well known, an obvious modification of Hillmer et al.

would have been to substitute one fraud algorithm for another (*In re Wolfe*, 116 USPQ 443, 444 (CCPA 1961); *Ex parte Smith*, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Internet World Magazine, John Pallatto, "Tracking Online Thieves: Online Merchants Arm Themselves With More Sophisticated Tools to Detect Fraud Around the Globe"
- Gopinathan et al. teach eFalcon fraud detection

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

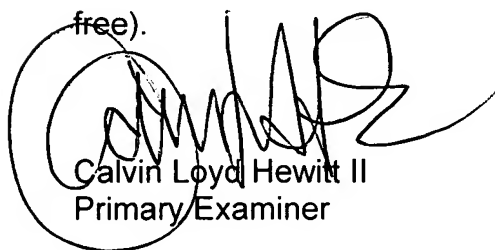
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information

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for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

A handwritten signature in black ink, appearing to read "Calvin Hewitt II", is written over a circular stamp. The signature is fluid and stylized, with the first name "Calvin" and last name "Hewitt" being more legible than the middle initial "Loyd".

Calvin Loyd Hewitt II
Primary Examiner

January 14, 2008